



UNITED STATES PATENT OFFICE BOARD OF APPEALS

In re Application of Steve Somers ()
Serial No. 10/007,189 (On Appeal From Examiner James Smith's
Application Filed 11-8-01 (Final Rejection
For Socket Wrench (Group Art Unit 3723

Applicant Somer's Appeal Brief

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(1) Real Party in Interest - Steve Somers, above named applicant.

(2) Related Appeals and Interferences - There are no related appeals or interferences.

(3) Status of Claims - Independent Claims 8, 13 and 15 and depending claims 9-12 and 16 are all finally rejected on the identical combinatin of references under Section 103 (a) and stand pending and on appeal. Claims 1-7 and 14 were cancelled before the final rejection and thus form no part of the appeal.

(4) Status of Amendments - There have been no amendments made subsequent to the final rejection, but there is an obvious need to make some claim amendments . Thus, 8 lines u p from the end of claim 8,"an"should be cancelled. Also, in line 8, of the section of claim 13 beginning with the words "a ball member " the word "same " should obviously be changed to "said" as it was in the previous form of the claim. I note also that my copy of claim 16 shows the claim ending in line 4 thereof. There are some lines which follow which do not belong with claim 16 or any other claim and should be cancelled.

Also, it has just been discovered that a very minor amendment is needed in line 4 of claim 12 where "said" obviously should be added before "driver member-receiving bores".

(5) Summaary of Invention -

As shown in Figs. 3 , the invention can be either in the form of an assembly of parts 20 or in the form of a dis-assembled number of parts shown in the exploded view thereof in Fig. 4. These parts can be quickly and easily assembled because of the advantageous manner in which these parts are designed, The parts include outermost left and a right main socket-forming and drive member-receiving parts 20a and 20b to be located at the opposite longitudinal ends of the assembled wrench. These parts are designed ultimately to be interconnected by a ball member-forming part 20c having preferably a cylindrical end 21 which fits within a similarly sized cylindrical bore 30 at the inner end of the left part 20a and a ball 36 at the other end thereof which fits within a preferably cylindrical bore 39 at the inner end of the right part 20b. The ball 36, in conjunction with a coil spring 42 which expands against the right end of the ball 36 and a pin 38 which passes through a slot 36a in the ball, enables the left and right parts 20 and 20b to be pivoted relative to each other. As covered by depending claim 11, the opposite ends of the ball-forming member are of substantially the same size so that either end of the ball-forming member 20c can be inserted into the bores 30 and 39 at the inner ends of the left and right parts so that the assembler of the parts need not be concerned as to which end if the ball-forming member fits into the bores 30 and 39.

Unlike the closest prior art Jarvis patent which discloses a very complex, difficult to use, multi-multi-aperture wrench, the present invention as claimed comprises a much simpler and easier to use wrench comprising the three parts 20a, 20b and 20c referred to above where the left and right outermost parts 20a and 20b which receive the separate ball-forming part 20c therebetween respectively have outer socket forming bores 24 and 26 opening onto the exteriors of these parts and defining differently sized non-circular sockets which are to be applied over differently sized elements, such as nuts to be rotated by the wrench. The inner ends of these socket-forming bores respectively open onto smaller driver member-receiving bores 25 and 27. These driver member-receiving bores 25 and 27 are adapted to interlock with an external drive member like 13 shown in FIG. 3 sized to be inserted into the adjacent open end of the associated larger socket 24 or 26 and then moved inwardly into the associated smaller driver member-receiving bore 25 or

27. Depending claim 12 recites that the driver member -receiving surfaces of the bores 25 and 27 are of the identical size and shape so that only one driver member is needed to rotate the wrench (while the other end thereof fits around the nut or other non-circular element to be rotated by the wrench) .

(6) Issues - All remaining claims 8-13, 15 and 16 were finally rejected only "under 35 U.S.C. 103(a) as being unpatentable over Jarvis or Martinez in view of either Gadberry or Bellows." The only explanation given as to why these patents in combination rendered the subject matter of all of the claims unpatentable under 35 U.S.C 103(a) is as follows:

"Jarvis or Martinez both show the claimed invention except for the use of a socket portion in both 'socket forming and driver-receiving parts' that has two different size apertures in each. Either Gadberry or Bellows suggests that a driver can have such a double aperture socket so that the drive receiving aperture is the inner aperture. It would therefore be obvious to one skilled in the art at the time the invention was made to modify Jarvis or Martinez by using a socket portion having two apertures per socket portion because either Gadberry or Bellows suggests the use of such a double aperture socket in a single tool." (Underlining added)

It is submitted that this rejection is deficient not only because this combination of references does not in fact teach the subject matter of the claims only taught by the disclosure of the present invention , but also because the Examiner has not shown a prima facie case of obviousness as required by the MPEP. Thus 706.02(j) of the MPEP states that :

"After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action: (A) the relevant teachings of the prior art relied upon , preferably with reference to the relevant column or page numbers where appropriate, (B) the difference or differences in the claims over the applied reference(s), © the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references) when combined must teach or suggest all of the claim limitations (underlining added). The teachings or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure."

The Examiner has thus not satisfied the analysis required by the MPEP in his blanket rejection of all of the claims presented, And by such cases as In re Vaeck, 947 F.2d 488, 20USPQ2d 1438 (CAFC, 1991) and In re Lee, 277 F.3d 1338,1341 (CAFC, 2002). In the latter case, the CAFC held that the Board erred when it said that "it was not necessary to present a source of the teaching, suggestion or motivation to combine these references or their teachings."

For reasons to be more fully explained in the Argument Section 8 to follow, the references combined to blanket reject all of the claims are so unrelated or different that one of ordinary skill in the art would not think of combining them to result in the meeting of all of the claim limitations involved. without the impermissible prior knowledge of applicant's invention.

(7) Grouping of claims. - Because claim 8 and 13 differ only as to whether or not the parts involved are in an assembled or dis-assembled condition, the Examiner and Board can select one or the other of these claims for its patentability analysis. Also, since independent claims 8 and claims 11 and 12 depending thereon differ materially in that the latter add believed different novel features to their parent claims, claims 11 and 12 should be separately considered from their parent claim 8. I also note that independent claim 15 and claim 16 which depends upon claim 8 positively claim the external driver member. However, since the other claims clearly relate the portion of the left or right driver member-receiving parts to the driver member they receive, claims 15 and 16 probably can be examined with claim 8 or 13.

(8) Argument --Since independent claims 8, 13 and 15 patentably distinguish from the applied combination of references for similar reasons, I will discuss in detail only the first independent claim 8. This claim recites various parts which when combined form a wrench which finds no counterpart in the prior art cited or applied, the latter being the ball member-containing wrenches of Jarvis or Martinez combined with the completely unrelated crank-handle wrenches of Bellows and Gadberry. In reviewing the comments to follow, the readers of this brief should keep in mind the comments made in the "issue" section of this brief where it was pointed out that the Examiner's final rejection did not explain how this prior art teaches or suggests " all the claim limitations". In fact, there are many limitations in the claims like claims 8, 13 and 15 which are not even present in any of these applied references and the examiner has not (because it is believed he cannot reasonably) explain how their combination could do so. Moreover, the ball member-containing Jarvis and Martinez references are so different from the crank handle-containing Bellows and Gadberry references that without the impermissible knowledge of applicant's disclosure, a person of ordinary skill would not think of trying to combine them.

In the claim language quotations to follow, reference numbers used in the drawings are inserted in the claim quotations which are located at or near the claim elements involved. Also, certain key words are underlined even though the underlining is not present in the claim involved.

Accordingly, claim 8 states that the wrench-making parts include "a left and a right external drive member means-receiving part (20a or 20b) each having a first outer end to be located at a different opposite longitudinal outer end of the wrench when the parts are assembled and an opposite second inner end, said left and right parts (20a and 20b) respectively having walls defining differently-sized, non circular sockets (24 and 26) in the first outer ends thereof to be located at the opposite longitudinal ends of the assembled parts and applied over differently sized elements to be rotated by the wrench, said sockets each having an end opening thereat onto the exterior of the part involved so that the socket can be applied over and its defining walls interlock with a selected element of

corresponding size to be rotated by said wrench and an opposite end opening onto a first smaller driver member - receiving bore (25 or 27), said first smaller driver member-receiving bore having bore-defining walls adapted to interlock with an external driver member means (23) sized to be inserted into the open end of the associated larger outer socket ((24 or 26) and then moved inwardly into the associated driver member-receiving bore (25 or 27) where it interlocks with said left or right part involved so that rotation of the driver member will rotate the wrench and turn said element enveloped by said socket at the other end of the assembled wrench”.

Claim 8 further recites “a ball member-forming part (20c) adapted to be secured to and between the said second inner ends of said left and right external driver member means-receiving parts (20a and 20b), the second inner ends of the left and right parts respectively having walls (30 and 39) defining a pair of ball member-receiving surfaces, at least one of which forms a ball-receiving bore (30 and 39); said member-receiving part (20c) having a ball-forming end (36) adapted to adjustably fit in said ball-receiving bore of one of said left and right parts (20a and 20b) and an (cancel “an”) a second end (21) adapted to be fixedly mounted against the ball member-receiving surfaces of the other of said left and right parts; and pivot-forming first and second means (38, 40 and 36a) permitting the pivoting of said ball-forming end (36) of said ball member-forming part in the ball-receiving bore involved (30 or 39) at least in a plane which includes a longitudinal axis extending between the outer ends of the wrench.”

. The claims recite bore sizes, shapes and part locations which are not found in any of the applied patents. How then can a combination of these patents do so? Even if each claim limitation could be read upon one of these references, the references themselves must still suggest to one of ordinary skill in the art how they can and should be combined in a single wrench without knowledge of applicant's disclosure. There are no such suggestions.

. The very complex and unclearly disclosed Jarvis construction hardly anticipates or renders unpatentable the claimed construction just reviewed. It discloses a wrench in Figures 1-11 which has what is called a first square drive section 7 projecting to the right of a cylindrical skirt portion 13. This skirt portion receives the ball end of what is called a square drive 23, which fits into an a multi-sized adapter 5. The adapter 5 has different

sized openings at the opposite ends thereof to be applied over different sized non-circular driver members not shown. It is unclear how the adapter 5 is used with the construction when the adapter 5 is to be attached to drive members of different size.

The right end of the square drive section 7 of the Jarvis patent is shown fitting into a socket member 3 which can be applied over a work piece not shown. Figures 1 and 10 of this patent show inconsistent bore sizes for the socket member 3 which is said to be applied over a work piece not shown. The specification of the Jarvis patent also unclearly describes the embodiment of Figures 12-18, which in many respects is similar to the Figure 1-11 embodiment of this patent. While it is unclear how the Jarvis embodiments are used, what is clear is that it does not disclose applicant's invention as described and claimed in claim 8 and the other claims. The only similarity is that both have a ball member which permit's the opposite ends of the wrench to be pivoted about a longitudinal axis. This is also true of the wrench disclosed in the Martinez patent which discloses a construction even more remote from applicant's invention than is the Jarvis wrench constructions.

As previously indicated, the hand crank constructions of the Bellows and Gadberry patents do not supply the deficiencies of the ball containing wrenches of Gadberry or Jarvis patents and are so remote from the subject matter of the latter patents that there is no suggestion or motivation either in the references themselves or in the knowledge generally available to one skilled in the art, to modify these references or to combine the reference teachings as required by the MPEP and the case law.

As previously indicated, claims 11 and 12 which depend upon claim 8 add further details to claim 8 which clearly are not disclosed or taught by the applied references. Claim 11 adds the feature that "the opposite ends of the ball-forming member are of substantially the same size and construction so that either end of the ball-forming member can be inserted into said bores of either one of said left and right driver member means-receiving parts". There is no teaching or disclosure of this subject matter in either one of the applied references and so their combination could ^{not} do so either.

The same lack of such a teaching or disclosure of the subject matter of claim 12 is

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in the applied references. Thus, claim, 12 recites "said driver member means-receiving surfaces of said driver member-receiving parts both form bores therein of identical size and shape so that said driver member means can be inserted into either one of driver member-receiving bores, whereby only one driver member is needed to rotate the wrench for the two different sizes of elements to be driven by the wrench."

It is noted that the features of claims 11 and 12 just reviewed are claimed in the context of claim 8 which includes the ball member-receiving parts of the wrench which fit between or are fittable between the right and left external driver member means-receiving parts. The applied references do not themselves separately or in combination to a wrench construction like that claimed. The fact that a hand crank wrench like that shown in the Bellows patent may have two shafts extending axially outward in opposite directions from a single hand crank arm does not teach a modification of the Jarvis or Martinez patents which do not use a single driver member or ball member which fits within bores of the same size as claimed..

If unexpectedly the Examiner repeats his final rejection with a more detailed explanation satisfying the examining requirements of the MPEP, then applicant requests an opportunity to respond thereto.

Attached hereto is an appendix with the claims on appeal in clean copy.

Respectfully Submitted,

Russell E Hattis 3-13-09

Russell E. Hattis, Attorney for applicant Steve Somers

Also enclosed is the appeal brief fee of \$165.



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9.

Applicant's Attorney hereby attests that he placed the attached Somer's Appeal Brief and the Appendix to the Appeal Brief in an envelope addressed to the Commissioner of Patents, P.O. Box 1450, Alexandria Va. 22313-1450 and mailed the same to t his Address by first class mail on March/3 , 2004.

A handwritten signature in cursive script that reads "Russell E. Hattis".

Russell E. Hattis, Applicant's Attorney